

R E M A R K S

The present amendment is in response to the Official Action dated March 16, 2007, wherein the Examiner continues to reject pending claims 35, 37-42 and 44-48, in each instance relying upon Ichikawa et al., US Patent No. 4,626,842, in support of an alleged anticipation. The Examiner has further rejected claims 35, 37-42 and 44-48, as further allegedly failing to comply with the written description requirement, and still further rejected the same claims as allegedly being directed to non-statutory subject matter.

In response to the Examiner's continued rejection of claims 35, 37-42 and 44-48, under 35 U.S.C. §102(b), as being anticipated by Ichikawa et al., US Patent No. 4,626,842, the applicants contend that contrary to the Examiner's assertions, even under the Examiner's most recent attempt to find an equivalent teaching in the cited reference with respect to a determination of type, the presently articulated rejection continues to fail to make known or obvious each and every feature of the claims, where most recently the Examiner attempts to rely upon the addressing of a message as being equivalent to a determination of message type. In the most recent action the Examiner cites to col. 2, lines 26-46 of Ichikawa et al., '842. However, contrary to supporting the Examiner's position, the specifically cited portion in fact teaches away from the Examiner's conclusions.

More specifically, the most recent attempt at articulating an equivalent teaching for the claimed determination based upon message type fails to make known or obvious the same. However, the most recent alleged equivalent structure does not refer to the type of message, but alternatively relates to the intended recipient of the message. If one is not the intended recipient of the message, then one does not receive the message as provided in connection with first routine (claim 35) or the claimed step of receiving a message comprising information (claim 42). A type of message does not change based upon the intended recipient. Alternatively, the identified recipient affects the routing and the receipt of the message.

Interestingly, even the reference treats the message frames (I) as being separate from the subscriber's address frame (N), when discussing the data structure of the paging channel (see FIGs. 2a, 2b and 2c, and col. 2, lines 47-50). Correspondingly, as one skilled in the art would be led to understand from the teachings of the cited reference, the type of message would be distinct from any attempted categorization or classification relative to the subscriber's address. As a

result, an attempt to equate the manner in which the message is addressed as making known or obvious the claimed feature of a message type (i.e. type of message) and any determination based thereupon can not be supported in view of the teachings reasonably attributable to the relied upon reference. Consequently, the Examiner's final rejection of the claims, based upon the most recent basis for rejection should be set aside and/or withdrawn.

As noted above, in addressing the specific section of the cited reference noted by the Examiner, namely col. 2, lines 26-46, the section refers to a "signal intercepted", because it is not until an address match is determined that the signal is in fact received, where prior to receipt of the message, "the decoder checks to see if the receiver is being addressed". Upon a determined address match, the message is received, an alert signal is produced, and a visual indication of the received signal on a per 10-digit basis is provided. Consequently, a determination of whether an intercepted signal should be received can hardly be a determination of a type of message that is received. In other words, communication signals that are not intended for the communication device are generally ignored and not received. Nevertheless, in an attempt to make the same even more clear, the applicants have amended the claims to more clearly identify the message that is being received as one that is intended for receipt by the communication device.

In regards to the Examiner's rejection of the claims based upon 35 USC 112, first paragraph, the Examiner appears to be looking for the exact phrasing that is being amended into the claims as being present in the disclosure materials. However, support for the exact phrasing is not required. It is only required that the ultimately claimed language be supported in such a way that one skilled in the art would understand that the inventors had possession of the later claimed invention at the time of filing.

More specifically, as articulated by the Federal Circuit, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It is well settled, that a determination as to whether the originally filed disclosure of the application reasonably conveys to the artisan an indication that the inventor had possession of the claimed subject matter, does not require that the claimed subject matter be

described identically. Precisely how close the original description must come in order to comply with the description requirement must be determined on a case-by-case basis. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) (emphasis added).

The first phrase for which the Examiner raises a concern is “wherein the type of message is different than the size of the message”, while the exact phrase may not be expressly provided, the phrase is a fair characterization of what one skilled in the art would understand that the inventors possessed at the time the application was filed relative to the subsequently claimed invention. It is specifically noted, that an explicit determination of size separate from a determination of type was already provided in the claims as originally filed (see at least original claims 35 and 36). The separate determinations fairly identify to one skilled in the art, the intention that the two characteristics are distinct. It is only when the Examiner attempts to converge the separately articulated features as being representative of the same thing, in order to read onto the claims the teachings of a reference which only attempts to show a distinction based upon size, that it becomes necessary to more clearly identify that message type represents a characteristic separate from message size. Nevertheless, the separate articulated determination would clearly set forth to one skilled in the art that a determination based on type, as provided in the claim is based on a determination criteria, that is different from size, especially where a separate determination based upon size is expressly provided.

In regards to the Examiner’s reference to “quickview”, where the Examiner alleges that the same is performed based on type of message which is directly based on the size of the message, the applicants are unable to reach the same conclusion based upon the a direct reading of the relevant sections of the specification, where one of the particular sections indicate that a particular channel can be specified by the user as a “quickview” channel (see page 12, lines 12-21). Another section then indicates, that if the message should be accorded quickview status, then it is further analyzed to determine its size (see page 12, lines 22-24). However there is no linkage to a determination of type being directly based on size. Such a characterization, while suggested by the Examiner (apparently inappropriately so), is not supported by the actual language used in the specification.

The second phrase for which the Examiner raises a concern is “criteria of the type”. However the original disclosure supports both “analyzing” in order “to determine”. Most determinations are based upon some form of criteria. As defined by the American Heritage

Dictionary, criteria means “[a] standard, rule, or test on which a judgment or decision can be based”. As such, because a determination (“to determine”) is originally provided by the claim, it is fair that the determination should be made based upon some criteria. Therefore usage of the term is fair in the claimed context, and more importantly the particular criteria identified are fairly associated with the determination as originally disclosed in the specification. Consequently, the particular phrase is in fact supported as required under 35 USC 112, first paragraph, and therefore no new matter is present, and the particular phrases specifically identified by the Examiner are appropriately present.

Regarding the Examiner’s allegations as to the claims being directed to non-statutory subject matter, MPEP §2106(IV)(B)(1)(b) effectively defines through example nonfunctional descriptive material as corresponding to certain types of descriptive material that is merely stored so as to be read or outputted by a computer without creating any functional interrelationship. This is more akin to a stored audio or video file, such as a song or a movie, which includes data that is not interpreted or analyzed, but is merely played back without describing how it is played back. However, the Examiner then fails to relate each and every feature of the claims, or any of the claims as a whole, as fitting with such a definition. Independent claim 35, and the claims which depend therefrom provide for a routine stored in a computer-readable medium and configured for execution by the processor, and therefore provides a function relative to the processor, that separates it from nonfunctional descriptive material, as it is used to define the operation of the processor. Furthermore, when the routines are made part of a structure stored on a computer readable medium, the subject matter expressly fits the description of functional descriptive material that is identified as being statutory, as set forth in MPEP §2106(IV)(B)(1)(a). Still further, storage on a computer readable medium provides for a tangible representation that distinguishes the claimed subject matter from merely being an abstract idea.

Regarding independent claim 42, amendments have been introduced to more clearly provide for an interaction, which produces physical effects including a receipt of messages and generation on a display.

In view of the present amendments and corresponding comments, the applicant would respectfully request that the Examiner reconsider the rejection of the claims. Should any issues remain unresolved after the consideration of the present response, the Examiner is requested to contact the applicant's representative at the number listed below to discuss the same.

Respectfully submitted,

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